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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,295	07/14/2003	Michael Lee	NKTZ 2 00061	6308
27885	7590	07/06/2005	EXAMINER	
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP			BLAU, STEPHEN LUTHER	
1100 SUPERIOR AVENUE, SEVENTH FLOOR			ART UNIT	
CLEVELAND, OH 44114			PAPER NUMBER	

3711

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/619,295

Applicant(s)

LEE, MICHAEL

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6,7,9,10,20-23 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6,7,9,10,20-23 and 26 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 26 is objected to because of the following informalities: Claim 26 depends on a canceled claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The change to claim 6 is agreed with and the rejection under 35 U.S.C. 112, second paragraph, is removed.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Viollaz.  
Viollaz discloses an insert being a foam Col. 2, Lns. 46-50).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-7, 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elkins in view of Viollaz.

Elkins discloses a muscle back surface having an upper ledge that generally follows the contour of the top edge, and a muscle back portion covering at least half of the surface area of the rear surface (Fig. 1).

Elkins lacks a cavity disposed in a muscle back portion with the cavity not visible from the exterior of a club and having no visible cavity thereon, and a cavity vertically spaced from the sole. Viollaz discloses a cavity not visible from an exterior of a club, a cavity vertically spaced from the sole (Figs. 4-5), having no visible cavity thereon (Figs. 1-9) and a cavity filled with a foamed urethane in the form of polyurethane (Col. 2, Lns. 46-50). In view of the patent of Viollaz it would have been obvious to modify the head of Elkins to have the cavity filled with foamed polyurethane in order to provide vibration dampening to a head at impact and in order to utilize a shock absorption material placed inside heads used in the market place. In view of the patent of Viollaz it would have been obvious to modify the head of Elkins to have a cavity not being visible from

an exterior of a club and having no visible cavity thereon, and a cavity vertically spaced from the sole in order to prevent the filling material from inadvertently exiting the cavity.

7. Claims 6-7, 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elkins in view of Godlen and Viollaz.

Elkins discloses a muscle back surface having an upper ledge that generally follows the contour of the top edge, and a muscle back portion covering at least half of the surface area of the rear surface (Fig. 1).

Elkins lacks a cavity disposed in a muscle back portion with the cavity not visible from the exterior of a club and having no visible cavity thereon, and a cavity vertically spaced from the sole. Golden discloses a blade surface being substantially parallel to a front surface, a muscle back surface defining a cavity, a cavity vertically spaced from the sole (Fig. 8A), a muscle back surface noting having a cavity as shown in figure 8A (Fig. 8B), a cavity have one or more holes to fill the cavity (Fig. 8A, Col. 6, Lns. 41-50), a head being formed of a metal (Col. 6, Lns. 51-61) and injecting a second material in a cavity with the appropriate of stiffness (Col. 6, Lns. 41-50). In view of the patent of Golden it would have been obvious to modify the head of Elkins to have a cavity disposed in a muscle back portion and a cavity vertically spaced from the sole in order to modify the stiffness of a muscle back portion.

Viollaz discloses a cavity not visible from an exterior of a club (Figs. 4-5), and having no visible cavity thereon (Figs. 1-9). In view of the patent of Viollaz it would have been obvious to modify the head of Elkins to have a cavity not being visible from

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an exterior of a club and having no visible cavity thereon in order to prevent the filling material from inadvertently exiting the cavity.

8. Claims 9 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elkins in view of Viollaz as applied to claims 6-7, 10 and 20 above; and further in view of Motomiya.

Elkins lacks an elastomer filling a cavity. Motomiya discloses filling a sealed space with an elastic filler material such as foamed urethane and rubber (Col. 2, Lns. 14-16). In view of the patent of Motomiya it would have been obvious to modify the head of Elkins to have a polyurethane being a high rebound foamed elastomer filling a cavity in order to utilize a type of urethane shock absorption material used in the market place inserted in cavities of heads.

### ***Response to Arguments***

9. The argument that it is improper to rely on the triangle of Elkins to indicate a cavity is agreed with. As such the examiner did not rely on Elkins to show this but used Viollaz and Golden to show that it is known to have cavities internal to a head. The statement "Since Elkins fails to disclose a cavity, one can only assume that Elkins is directed to a muscle back iron" is disagreed with. This statement implies that if one placed a cavity in the muscle back portion of Elkin that Elkin would no longer be a muscle back iron. Clearly there can be a muscle back portion with a cavity and an

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insert in the cavity. Golden shows this. In fact Golden and Viollaz both show adding weight behind a face by adding a shell with filling material. The cavity and filling material adds additional features in addition to weight behind a face which a blade head does not have. The argument that it is improper to combine the references of Elkins and Viollaz due to the combination not producing a corrective bias as the applicant's head performs is disagreed with. There can be other reasons to combine references as adding shock absorbing abilities as the examiner suggests. The argument that it is improper to use Golden to reject claim 22 due to high rebound insert in the cavity would destroy the intended function of Golden is agreed with. Rubber material or foam in a cavity behind a face would not add the stiffness as Golden is attempting to achieve. As such this action is not made final.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 4 July 2005



**STEPHEN BLAU**  
**PRIMARY EXAMINER**